

PUBLIC VERSION

**UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C.**

In the Matter of)
)
CERTAIN RUBBER)
ANTIDEGRADANTS, COMPONENTS)
THEREOF, AND PRODUCTS)

CONTAINING SAME)

Investigation No. 337-TA-533

Order No. 31: Granting KKPC's Motion To Compel

On October 11, 2005 respondent Korea Kumho Petrochemical Co., Ltd. (KKPC) moved to compel complainant to produce documents relevant to the licensing and on-sale bar defenses to the patents in issue, and specifically KKPC's Eight Set of Document Request Nos. 226-229, 235, 240, 245, 255 and 256 (Exh. D to motion). (Motion Docket No. 533-43.)

Complainant, in a response dated October 17, 2005, argued that the pending motion should be denied.

No other party responded to the pending motion.

Licensing Defense

KKPC, on its licensing defense, refers to Document Request Nos. 240 and 245 as well as Request Nos. 226, 227, 228, 229 and 256 (See pages 2-3 of supporting memo). Complainant, in opposing KKPC's Motion To Compel, argued that KKPC's licensing defense is a "bogus defense" (memo at 6). However the administrative law judge is not determining, through KKPC's motion to compel, the merits of KKPC's licensing defense. Rather the issue is whether the information sought appears reasonably calculated to lead to discovery of admissible evidence. See Commission rule 210.27(b). Moreover the burden of proving that an issue is beyond

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discovery rests squarely with the party resisting the discovery. See Certain Encapsulated Integrated Circuit Devices and Products Containing Same, Inv. No. 337-TA-501, Order No. 50 (May 18, 2004).

It is not denied that in 1987, complainant's predecessor-in-interest, Monsanto Chemical Company, and KKPC entered into a{

} (Exh. B to motion); that under this{ } Monsanto and KKPC created Kumho Monsanto, Inc. (KMI) to{

} and that under the terms of the KMI{

} Monsanto provided KMI with{

}

Complainant argued that the{

}; that any obligation that Monsanto had would have been

"limited to{ };" and that Monsanto never

{ } Complainant,

at the hearing, will have the opportunity to establish through evidence such arguments.

However the administrative law judge finds that complainant, in its arguments, has not met its burden in establishing that the requests in issue are beyond discovery. Hence complainant is ordered to fully respond to Document Request Nos. 226, 227, 228, 229, 240, 245 and 256 by the close of business on October 28. If there are no documents in existence, responsive to said requests, complainant should provide a declaration, by October 28, to that effect.

On-Sale Bar Defense

KKPC argued that documents produced by complainant reveal that its purportedly non-

commercial “pilot plant” produced{

} years prior to the priority date of the ‘111 patent; that KKPC’s manager, who visited the pilot plant in late 1992, was told by Monsanto personnel working at the pilot plant that{

} that in complainant’s pilot plant manager’s deposition, said manager did not dispute this account but stated that he was unaware of what happened to this{

}; and that he believed{ } KKPC argued that it is for this reason that KKPC seeks shipment and other records of the disposition of said{

} Complainant argued that the purpose of the pilot plant, also known as the{ } plant, was entirely{ } However KKPC is entitled to any documents, if such exist, that may be inconsistent with said “argument.” Hence complainant is ordered to produce, no later than the close of business on October 28 all documents in existence and responsive to Document Request Nos. 235 and 255 and which relate in any way to the{

}

Complainant argued that it is unclear why KKPC is seeking from complainant what are “obviously” Monsanto records of the{

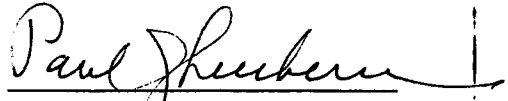
} If complainant has no documents in issue, complainant should produce a declaration, no later than October 28, to that effect.

Motion No. 533-43 is granted.

On October 18, 2005, each of the private parties and the staff received a copy of this

order.

This order will be made public unless a bracketed confidential version is received no later than the close of business on October 28, 2005.


Paul J. Luckern
Administrative Law Judge

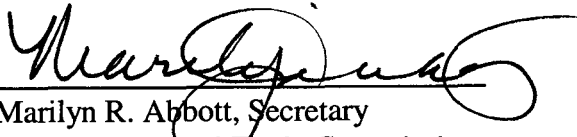
Issued: October 18, 2005

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CERTIFICATE OF SERVICE

I, Marilyn R. Abbott, hereby certify that the attached **Public Version Order** was served by hand upon Commission Investigative Attorney Juan Cockburn, Esq. and upon the following parties via first class mail, and air mail where necessary, on April 26, 2006.



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CERTIFICATE OF SERVICE page 2

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